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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,246	02/21/2002	Yasushi Hirumi	09792909-5345	8451

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EXAMINER

TRAN, HUAN HUU

ART UNIT	PAPER NUMBER
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2861

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/080,246

Applicant(s)

HIRUMI ET AL.

Examiner

Huan H. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 11, 15-24, 26 and 27 is/are rejected.
- 7) ☒ Claim(s) 8-10 and 12-14 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>07/09/02</u> . | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3, 17, 18, 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Koyama (US Patent 6382852)

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C.

102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

As to claim 1, Koyama discloses a printing apparatus (and a corresponding method) comprising:

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image-data-forming means which forms data of an image to be printed on a film sheet (see Col. 7, lines 6-8; Col. 11, lines 32-49);

energy-applying means which generates energy and applies the energy to the film sheet (thermal head 40) ; and

energy-control means (head controller 74 at Col. 7, lines 11-21; Col. 11, lines 33-49) which controls the energy applied to the film sheet by the energy-applying means on the basis of the image data and changes a property of the film sheet, thereby forming the image.

As to claim 1, Koyama clearly teaches the limitation " wherein the energy generated by the energy-applying means is thermal energy." As disclosed in Koyama a thermal head 40 is used for recording.

As to claim 3, Koyama teaches the limitation " wherein the property of the film sheet, the property being changed in accordance with the energy applied, is glossiness" See Col. 7, line 16.

As to claims 17-19, under the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device. When the prior art device is the same as a device described in the specification for carrying out the claimed method, it can be assumed the device will inherently perform the claimed process. In re King, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986). See MPEP 2112.02. Therefore, the printing method set forth in the claims are anticipated by Koyama for the reasons given in the rejection of claims 1-3.

4. Claims 4-6, 7, 16, 20-22, 23 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kono et al. (JP 07-052428).

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As to claim 4, Kono et al. discloses a printing apparatus which prints an image on the surface of a print medium (card 37) and which forms a film layer (film F) on the image-printed surface of the print medium (see paragraph [0027], the printing apparatus comprising:

first image-data-forming means (frame memory 80 at paragraph [0030] which forms data of the image to be printed on the surface of the print medium ;

second image-data-forming means (memory 86 at paragraph [0032] which forms image to be printed on the surface of the film layer;

printing means (printing head 48 at paragraph [0029] which prints the image on the print medium on the basis of the image data formed by the first image-data-forming means;

energy-applying means (head 48) which generates energy and applies the energy to a film sheet disposed over the image- printed surface of the print medium so as to form the film layer; and

energy--control means (CPU 81) which controls the energy applied to the film sheet by the energy-applying means on the basis of the image data formed by the second-image-data-forming means and changes a property of the film sheet while transferring the film sheet onto the image-printed surface of the print medium, thereby forming the image 9 (see paragraph [0038].

As to claim 5, Kono et al. teaches the limitation " wherein the energy generated by the energy-applying means is thermal energy. " in that a thermal printing head 48 is used.

As to claim 6, Kono et al. teaches the limitation " wherein the property of the film sheet, the property being changed in accordance with the energy applied, is glossiness." See paragraph [0038].

As to claims 20-22, under the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device. When the prior art device is the same as a device described in the specification for carrying out the claimed method, it can be assumed the device will inherently perform the claimed process. In re King, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986). See MPEP 2112.02. Therefore, the printing method set forth in the claims are anticipated by Kono et al. for the reasons given in the rejection of claims 4-6.

As to claims 7, 23, Kono et al. discloses _with reference to Fig. 7 and paragraphs [0029] to [0038]- a printing apparatus and corresponding method comprising:

means (memory 80) or step for receiving the image information (print data S10) and obtaining the information (SF) associated therewith, the associated information is added information that is input or selected by input/operation means (selector 85) in accordance with the image information;

means (head 48) or step for printing the image information on the print medium; and

means (head 48) or step for covering the image-printed surface of the print medium (37) with a film sheet (F) and forming the associated information on the film sheet as a watermark (by matte processing the film F).

As to claim 16, although Kono et al. does not explicitly disclose data storage unit for storing font data for forming characters and symbols representing the associated information, it is submitted that such unit is inherent in order for the alphabetic characters associated with the additional information to be printed in Kono et al.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 11, 15, 24, 26, 27 are rejected under 35 U.S.C. 103(a) as being obvious over Kono et al. in view of Koyama.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

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As to claims 11 and 24, Kono et al. discloses essentially the claimed invention except that it does not specifically disclose that the predetermined alphabetic character (additional/associated information) is related to date.

Koyama teaches that the additional information is date. See Fig. 9.

Therefore it would have been obvious to one of ordinary skill in the art to combine the teaching of Koyama and Kono et al. to provide date information in the film F to the record medium 37.

As to claims 15, 26 and 27, Koyama teaches the concept of controlling the glossiness in accordance to applied energy (Fig. 8). Therefore it would have been obvious to one in the art to apply the teaching of Koyama in the printing apparatus/method of Kono et al. to control the glossiness of the film F.

Allowable Subject Matter

7. Claims 8, 9, 10, 12, 13, 14, 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huan H. Tran whose telephone number is (571) 272-2261. The examiner can normally be reached on at work on W-F from 6:30 to 5; T are telework days.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Talbott can be reached on (571) 272-1934. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Huan H. Tran
Primary Examiner
Art Unit 2861

hht
10/27/05